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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,523

Applicant(s)

JOSEPH ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/2/2005 & 10/6/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/14/2004</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 10,11,13-25,27-29,31-39,41-43,45-55,57-59,61-67,246-253 and 260-263.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment received on 5/2/2005 is acknowledged and entered. Claims 10, 17, 25, 27-29, 38, 57-58, 260 and 263 are currently amended. Claims 26 and 56 are canceled. The applicant has also indicated amending claim 53 (see page 7 of the Amendment filed on 5/2/2005) but it is not included in the submitted amendments on pages 2-6 and as such an amendment to claim 53 is not entered. Currently claims 10,11,13-25, 27-29, 31-39,41-43,45-55, 57-49,61-67,246-253 and 260-263 are pending for examination.

Response to Arguments

2.1. Applicant's arguments (see pages 16-21) filed on 10/6/2004 concerning rejection of claims under 35 USC 251 have been fully considered but they are not persuasive.

The applicant argues (a) that the broader aspects of the reissue claims do not relate to surrendered subject matter (see page 18) (b) that the claims presented in the reissue application are fully supported by the specification such that 35 USC 112, first paragraph is satisfied (see page 20) and (c) that nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application (see page 20) and therefore they do not believe that a limitation from the issued independent claims of the '034 patent is required within the independent claims of the present reissue application in order to satisfy the "original invention" requirement. The examiner respectfully disagrees. See MPEP 1412.02 Recapture of Canceled Subject Matter [R-3].

A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *Pannu v. Storz Instruments Inc.*, 258

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F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

I. THREE STEP TEST FOR RECAPTURE:

In Clement, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. In *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600, the court restated this test as follows:

Application of the recapture rule is a three-step process.

The first step is to 'determine whether and in what aspect the reissue claims are broader than the patent claims.'....

'The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter'

Finally, the third step is to determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

In the present case, on applying the above three step test for recapture, we find that the present reissue claims as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the reissue is based.

A. The First Step - Was There Broadening?

Yes, there is a presence of broadening in the present reissue application when compared with the scope of the claims of the patent to be reissued (see Office action mailed on 7/9/2003 on pages 2-5 and below under the head " Claim Rejections- 35USC 251). A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim.

B. The Second Step - Does Any Broadening Aspect of the Reissued Claim Relate to Surrendered Subject Matter?

Yes, the broadening aspect(s) of the reissue claims relate to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). The limitations of the patent claims, which are omitted or broadened in the reissue claim was originally relied upon by applicant in the original application to make the claims allowable over the art (***see the prosecution history of '034 patent, specially the Amendment and remarks received on 1/12/1998 wherein the applicant has explicitly argued and relied upon the limitations now omitted from the reissue claims to overcome the prior art***) and therefore the omitted limitation relates to subject matter previously surrendered by applicant.

C. The Third Step - Were the reissued claims materially narrowed in other respects to compensate for the broadening in the area of surrender, and thus avoid the recapture rule?

When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. If the reissue claim "fails" either analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement, supra*.

In the present case, the limitations of the patent claims, which are omitted or broadened in the reissue claim was originally relied upon by applicant in the original application to make the claims allowable over the art (see the prosecution history of '034 patent, specially the Amendment and remarks received on 1/12/1998 wherein the applicant has explicitly argued and relied upon the limitations now omitted from the reissue claims to overcome the prior art) and thus the reissue claims "fail" the analysis, and therefore recapture exists.

2.2. Applicant's arguments (see pages 21-24) filed on 10/6/2004 concerning rejection of claims 10,11,13-25, 27-29,31-39,41-43,45-55, 57-59,61-67,246-253 and 260-263 under 35 USC 103 have been fully considered but they are not persuasive.

With regards to claim 10 [claim 10 is considered as an exemplary claim), the applicant argues that Schlafly discloses more than a single action with respect to client because in Schlafly a user is required to provide an individual subscriber secret personal

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authorization number followed by prompts responsive to which the user enters a code specifying a supplier , the nature of the transaction, quantity and options pertaining to the relevant order and therefore, Schlafly does not disclose placing an order for an item by a single action with respect to a client. The examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the previously stored information related to ordering an item cannot include an individual subscriber secret personal authorization number followed by prompts responsive to which the user enters a code specifying a supplier, the nature of the transaction, quantity and options relating to an item being ordered) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the applicant's disclosure (see at least '034 patent, col.8, line 34-col.9, line 2) teaches receiving and storing information related to the item being purchased and personal information of the user by interacting with the user).

The applicant further argues that the prior art does not disclose the currently added limitation that is, receiving of data at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale. The examiner respectfully disagrees. Florin does disclose these limitations (see col.24, lines 7-39 and Figs. 45-48) which enable the user to receive data including information to at least one of show (that is the Advertiser's show, for example of " The Attic at Cacy"s in Fig.45) and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale (see Figs. 46-

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48 which show that an item is identified by its name, such as "Lucks Mini Espresso" and this item is currently being offered for sale and it is described in Fig.48).

2.3. In view of the current amendment made to claim 17, rejection of this claim under 35 USC 112, second paragraph is withdrawn.

In view of the foregoing, the rejection of all the currently pending claims under 35 USC 251 and 103 (a) are maintained. This is a Final Office action.

Claim Rejections - 35 USC § 251

3. Claims 10,11,13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253, and 260-263 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

At a minimum, the claims require at least one of the following limitations which were

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argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,908 application:

a source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted

or

a client computer, which includes a packet selector connected to said source for selecting and directing packets containing said auxiliary data representing said video program to a video signal processor and selecting and directing packets containing said associated distributed computing application to a further processor

or

further processor including means to assemble said distributed computing application and execute said distributed computing application to form an interactive video program in which execution of said distributed computing application alters said video program

or

a source of a time division multiplexed packet signal including a plurality of distributed computing applications, each distributed computing application being repetitively transmitted independent of receiving client computer apparatus, and each of said distributed computing applications being in a form of a series of packets

or

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a first one of packets of a respective series containing data representing an executable code module and including identification information indicating that the first one of packets of said series contains data representing said executable code module

or

the client computer extracts said directory module from the data stream and using data contained in the directory module extracts packets associated with said distributed computing application and builds said distributed computing application and executes said distributed computing application

or

read/write memory, coupled to the system bus;

a data stream input/output adapter, coupled between the data stream receiver and the system bus, for receiving the extracted distributed computing application representative data from the data stream receiver, and storing it in the read/write memory, and having a control output terminal coupled to the selection control input terminal of the data stream selector, for producing the selection control signal; and

a processor, coupled to the system bus, for controlling the data stream input/output device to generate a selection control signal selecting a specified one of the plurality of data streams, and for assembling and executing the distributed computing application stored in the read/write memory.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10, 12, 15, 16, 21-25, 28, 33-36, 38, 40, 43, 50-54, 58, 60, 63-66, 260, 262, and 263 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pat. No. 5,621,456, Florin et al (hereinafter Florin) in view of Pat. No. 4,734,858, Schlafly.

As to claim 10, Florin discloses a method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method comprising (i.e. home shopping interface)(see Fig. 1, and col. 23, line 59 - col. 24, line 7):

receiving data at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale (see col.24, lines 7-39 and Figs. 45-48 discloses receiving data including information to at least one of show (that is the Advertiser's show, for example of " The Attic at Cacy"s in Fig.45) and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale (see Figs. 46-48 which show that an item is identified by its name, such as "Lucks Mini Espresso" and this item is currently being offered for sale and it is described in Fig.48).

showing or describing the item to a user via the client (i.e. full motion video display of various paid for commercials or advertising messages)(see Fig. 44-50 and col. 23, line 67 - col. 24, line 7);

enabling the user to place an order for the item by a single interaction with the client (see Fig. 45-50, order button 409); and

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in response to the single interaction with the client, causing the order for the item to be placed (i.e. select button is depressed to order the product)(col. 24, lines 39-53). Florin does not explicitly disclose ordering the item by a single action with the client; and wherein the enabling of the user to order the item by a single action includes using 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed and 2) the item finder to enable the client to identify the item as currently being offered for sale at the time at the time of the single action.

However Schlafly discloses order the item by a single action with the client (i.e. once the item has been specified, it can be reviewed and modified or it can be stored in a send memory at 92 and later caused to be sent by automatic dialing of the local processing center ...)(col. 7, lines 35-46). In addition, Schlafly discloses wherein the enabling of the user to order the item by a single action includes using 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed (i.e. user ID number is then stored in the send memory)(col. 9, lines 12 21) and 2) the item finder to enable the client to identify the item as currently being offered for sale at the time of the single action (i.e. order information including the item code)(col. 9, line 52 - col. 10, line 10). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include order the item by a single action with the client; and wherein the enabling of the user to order the item by a single action includes using 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the

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user related personal information each time a further order is placed and 2) previously received information related to the item being offered for sale at the time of the single action as disclosed by Schlafly within Florin for the motivation of allowing consumers to order goods from a wide variety and broad range of suppliers (col. 1, lines 36-41).

As to claim 15, Florin discloses the method of claim 10, wherein the distributed computing system is an interactive television system and wherein the showing or describing of the item is, at least in part, by television signal (i.e. TV Shop is presented as a television channel)(col. 23, lines 59-67).

As to claim 16, Florin discloses the method of claim 10, wherein the client includes an auxiliary data processor (unit 77) and a client computer (unit 62)(see Fig 2).

As to claim 21, Florin discloses the method of claim 10, wherein the system further includes a central processing facility in communication with the server and wherein the method comprises:

 sending information used in processing the order from the client to the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 22, Florin discloses the method of claim 10, further comprising: sending an order confirmation to the user to confirm the order (i.e. a confirmation of the order along with a delivery time is displayed to the user)(col. 24, lines 53-58).

As to claim 23, Florin discloses the method of claim 21, further comprising:

communicating information between the client and the server via the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 24, Florin discloses the method of claim 23, wherein a telephone system acts as the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 25, Florin discloses the method of claim 10 including receiving at the client data including. Florin does not disclose information to enable the user to order the item by the single action with respect to the client. However, Schlafly discloses information to enable the user to order the item by the single action with respect to the client (i.e. user ID number is then stored in the send memory)(col. 9, lines 12-21). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include information to enable the user to order the item by the single action with respect to the client as disclosed by Schlafly within Florin for the motivation of allowing consumers to order goods from a wide variety and broad range of suppliers (col. 1, lines 36-41).

As to claim 28, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 33, Florin discloses the method of claim 28, including providing the information in the form of a television signal (i.e. TV Shop is presented as a television channel)(col. 23, lines 59-67).

As to claim 34, Florin discloses the method of claim 28 including communicating with a central processing facility and wherein the client sends the order to the central processing facility for receipt via a transceiver (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1, transceiver 54 and col. 8, lines 19-31).

As to claim 35, Florin discloses the method of claim 34 wherein a telephone system acts as a central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 36, Florin discloses the method of claim 28 including providing an order confirmation to the client to confirm the order (i.e. a confirmation of the order along with a delivery time is displayed to the user)(col. 24, lines 53-58).

As to claim 38, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 43, Florin discloses the system of claim 38, wherein the distributed computing system is an interactive television system and wherein the showing and/or describing of the item by the data processing system is, at least in part, performed utilizing a television signal (i.e. TV Shop is presented as a television channel)(col. 23, lines 59-67).

As to claim 49, Florin discloses the system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 50, limitations are closely parallel to the limitations already covered in claim 22 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 51, Florin discloses the system of claim 49, wherein the central processing facility is to communicate information between the client and the server (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 52, Florin discloses the system of claim 51 wherein a telephone system acts as the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 53, limitations are closely parallel to the limitations already covered in claim 25 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 58, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 63, Florin discloses the system of claim 58, wherein the data source is to provide the information in the form of a television signal (i.e. TV Shop is presented as a television channel)(col. 23, lines 59-67).

As to claim 64, Florin discloses the system of claim 58 including a data transceiver to communicate with a central processing facility and wherein the client sends the order to the central processing facility for receipt via the data transceiver (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1, transceiver 54 and col. 8, lines 19-31).

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As to claim 65, Florin discloses the system of claim 64 wherein a telephone system acts as the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1, transceiver 54 and col. 8, lines 19-31).

As to claim 66, Florin discloses the system of claim 58 wherein the data source is to provide an order confirmation to the client to confirm the order (i.e. a confirmation of the order along with a delivery time is displayed to the user)(col. 24, lines 53-58).

As to claim 260, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 262, Florin discloses the machine-readable medium of claim 260, wherein the medium comprises a mass storage device(i.e. central file server)(Fig. 1 and col. 3, lines 2-8).

As to claim 263, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

6. Claims 11, 29, 39, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claims 10, 28, 38, and 58 above, and further in view of

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Zachary et al., "Technology: HP is building Gadget to Make TVS Interactive" (hereinafter Zachary).

As to claim 11, Florin and Schlafly do not explicitly disclose the method of claim 10, wherein the single action includes at least one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

However, Zachary discloses an interactive TV system including a TV control box and a remote controller so that a home user can shop (see abstract and page 1). While shopping on the interactive TV system, a user can press the remote controller to place an order for a product (see abstract and page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 10, wherein the single interaction is one of the group including selecting of a single button and pressing of a single button on a TV remote control as disclosed by Zachary within Florin and Schlafly in order to make it easier for customer to make a purchase after watching an ad (see page 2, paragraph 9).

As to claims 29, 39, and 59, the claims are similar in scope to claim 11 and are rejected for the same reasons.

7. Claims are 13,14,17, 31, 32, 41, 42, 45, 61, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claims 10, 28, 38, and 58 above, and further in view of Pires, Pat. No. 4,163,255.

As to claim 13, Florin does not explicitly disclose the method of claim 10, wherein the personal information includes at least one of the group including a user's name, address, method of payment and payment account number.

However, Pires discloses a billing method for a subscriber of a pay television system (see abstract). Pires further discloses storing a customer identifier in client memory (i.e. decoder) along with order information including a program identifier to identify the program being ordered (col. 3, lines 27-33 and col. 4, lines 5-18 and lines 46-52). The customer and program identifiers are then transmitted from the client (i.e. decoder) to the central computer (col. 4, lines 46-52). Although Pires does not disclose the personal information includes at least one of the group including user's name, address, method of payment and payment account number, Pires does transmit the customer identifier which identifies the customer ordering the item. Transmitting a customer identification number is equivalent to providing the user's name since both means identify the user submitting the order. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 12, wherein the personal information includes at least one of the group including a user's name, address, method of payment and payment account number as disclosed by Pires within Florin and Schlafly in order to furnish a billing system which is reliable and operates with a minimum of user effort (col. 1, lines 32-36).

As to claim 14, Florin does not explicitly disclose the method of claim 10, wherein the personal information is stored in memory in the client.

However, Pires discloses a billing method for a subscriber of a pay television system (see abstract). Pires further discloses storing a customer identifier in client memory (i.e. decoder) along with order information including a program identifier to identify the program being ordered (col. 3, lines 27-33 and col. 4, lines 5-18 and lines 46-52). The customer and program identifiers are then transmitted from the client (i.e. decoder) to the central computer (col. 4, lines 46-52). Although Pires does not disclose the personal information includes at least

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one of the group including user's name, address, method of payment and payment account number, Pires does transmit the customer identifier which identifies the customer ordering the item. Transmitting a customer identification number is equivalent to providing the user's name since both means identify the user submitting the order. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 12, wherein the personal information is stored in memory in the client as disclosed by Pires within Florin and Schlafly in order to furnish a billing system which is reliable and operates with a minimum of user effort (col. 1, lines 32-36).

As to claim 17, Florin does not explicitly disclose the method of claim 10, wherein the client is associated with at least a set top box, and wherein the personal information is stored at the set top box.

However, Pires discloses a billing method for a subscriber of a pay television system (see abstract). Pires further discloses storing a customer identifier in a set top box (i.e. decoder) along with order information including a program identifier to identify the program being ordered (col. 3, lines 27-33 and col. 4, lines 5-18 and lines 46-52). The customer and program identifiers are then transmitted from the set top box (i.e. decoder) to the central computer (col. 4, lines 46-52).

Although Pires does not disclose the personal information includes at least one of the group including user's name, address, method of payment and payment account number, Pires does transmit the customer identifier which identifies the customer ordering the item. Transmitting a customer identification number is equivalent to providing the user's name since both means identify the user submitting the order. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 12, wherein the client is associated with at least a set top box, and wherein the personal information is stored at the set

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top box as disclosed by Pires within Florin and Schlafly in order to furnish a billing system which is reliable and operates with a minimum of user effort (col. I, lines 32-36).

As to claims 31, 32, 41, 42, 45, 61, and 62, the claims are similar in scope to claims 13, 14, and 17 and the claims are rejected for the same reasons.

8. Claims 37, 54, 55, 67 and 246-253 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claims 25, 28, 53, and 58 above, and further in view of Harvey et al., Pat. No. 4,965,825 (hereinafter Harvey).

As to claim 246, Florin does not explicitly disclose the method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single interaction with the client.

However, Harvey discloses an interactive television system where a central broadcast location includes signals carrying commands, executable code (i.e. control instructions) and data and transmits the signal for receipt by computer systems at viewer locations (col. 6, lines 43-62 and col. 13, line 54- col. 14, line 8). The transmitted signals contain control instructions that control the client computer (instructions are addressed to and control the microcomputer 205 of each subscriber station)(col. 12, lines 47-57). The user can then input information under control of signals embedded in the transmitted datastream (i.e. broadcast signal)(col. 13, lines 31-41). Furthermore, Harvey discloses an using the interactive television system to allow users to order items (i.e. Or if you enter on your Widget Signal Generator TV568* and Local Input the information that you see here on your screen ... the ingredients you need for your recipe will be delivered in time for dinner tomorrow.)(col. 280, line 58-vol. 281, line 5, line 61 -68). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 25 wherein the information to enable includes code executable by the

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client to enable the user to order the item by the single interaction with the client as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e. information stream) to many different clients (i.e. different apparatus at subscriber stations) and transmit standardized programming that is simple for users to play and understand (col. 6, lines 43-63).

As to claim 247, Florin does not explicitly disclose the method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single interaction with the client. However, Harvey discloses an interactive television system where a central broadcast location includes signals carrying commands, executable code (i.e. control instructions) and data and transmits the signal for receipt by computer systems at viewer locations (col. 6, lines 43-62 and col. 13, line 54- col. 14, line 8). The transmitted signals contain control instructions that control the client computer (instructions are addressed to and control the microcomputer 205 of each subscriber station)(col. 12, lines 47-57). The user can then input information under control of signals embedded in the transmitted datastream (i.e. broadcast signal)(col. 13, lines 31-41). Furthermore, Harvey discloses an using the interactive television system to allow users to order items (i.e. Or if you enter on your Widget Signal Generator TV568* and Local Input the information that you see here on your screen ... the ingredients you need for your recipe will be delivered in time for dinner tomorrow.)(col. 280, line 58-vol. 281, line 15 and line 61 -68). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single interaction with the client as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e.

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information stream) to many different clients (i.e. different apparatus at subscriber stations) and transmit standardized programming that is simple for users to play and understand (col. 6, lines 43-63).

As to claims 248-253, the claims are similar in scope to claims 246 and 247 and are rejected for the same reasons.

As to claim 37, Florin does not explicitly disclose the method of claim 248 including multiplexing, the provision of the information and the code to the client to thereby generate data for transmission to the client.

However, Harvey discloses multiplexing, the provision of the information and the code to the client to thereby generate data for transmission to the client (i.e. the present invention has the capacity for transmitting data and control instructions in the same information stream to many different apparatus at a given subscriber station)(col. 6, lines 49-63, col. 22, lines 62-65 and col. 23, lines 15-44). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 248 including multiplexing, the provision of the information and the code to the client to thereby generate data for transmission to the client as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e. information stream) to many different clients (i.e. different apparatus at subscriber stations) and transmit standardized programming that is simple for users to play and understand (col. 6, lines 43-63).

As to claim 54, Florin does not explicitly disclose the system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to show and/or describe from the data and a packet data extractor to extract the information to enable from the data. However, Harvey discloses multiplexing, the provision of the information and the code to the client to thereby generate data for transmission to the client (i.e. the present invention has the capacity for transmitting data and control instructions in the same information stream to many different apparatus at a given subscriber station)(col. 6, lines 49-63, col. 22, lines 62-65 and col. 23, lines 15-44). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to show and/or describe from the data and a packet data extractor to extract the information to enable from the data as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e. information stream) to many different clients (i.e. different apparatus at subscriber stations) and transmit standardized programming that is simple for users to play and understand (Col. 6, lines 43-63).

As to claim 55, the claim is similar in scope to claim 54 and is rejected for the same reasons.

As to claim 67, the claim is similar in scope to claim 37 and is rejected on the same basis.

9. Claims 27 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claim 26 above, and further in view of Harvey.

As to claim 27, Florin does not explicitly disclose the method of claim 26 wherein the item identifier includes any one of a group of identifiers including a code and a command. However,

Harvey discloses an interactive television system where a central broadcast location includes signals carrying commands, executable code (i.e. control instructions) and data and transmits the signal for receipt by computer systems at viewer locations (cot. 6, lines 43-62 and cot. 13, line 54- cot. 14, line 8). The transmitted signals contain control instructions that control the client computer (instructions are addressed to and control the microcomputer 205 of each subscriber station)(col. 12, lines 47-57). The user can then input information under control of signals embedded in the transmitted datastream (i.e. broadcast signal)(col. 13, lines 31-41). Furthermore, Harvey discloses an using the interactive television system to allow users to order items (i.e. Or if you enter ,1 ,on your Widget Signal Generator TV568* and Local Input the information that you see here on your screen ... the ingredients you need for your recipe will be delivered in time for dinner tomorrow.)(col. 280, line 58-vol. 281, line 15 and line 61-68). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 26 wherein the item identifier includes any one of a group of identifiers including a code and a command as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e. information stream) to many different clients (i.e. different apparatus at subscriber stations) and transmit standardized programming that is simple for users to play and understand (cot. 6, lines 43-63).

As to claim 57, the claim is similar in scope to claim 27 and is rejected on the same basis.

10. Claim 261 is rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claim 260 above, and further in view of Harvey.

As to claim 261, the claim is similar in scope to claim 37 and is rejected for the same reasons.

11. Claims 18-20 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claims 10 and 38 above, and further in view of Mustafa et al., Pat. No. 4,789,895 (hereinafter Mustafa).

As to claim 18, Florin does not explicitly disclose the method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further comprises:

the client retrieving information from one or more of the local computer and the associated storage. However, Mustafa discloses the set top box (unit 33) is in communication with a local computer and associated storage and wherein the method further comprises the client retrieving information from one or more of the local computer and the associated storage (see Fig. 1, col. 3, lines 12-20, col. 4, lines 3-20, and col. 6, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the set top box is in communication with a local computer and associated storage and wherein the method further comprises the client retrieving information from one or more of the local computer and the associated storage as taught by Mustafa within Florin and Schlafly in order to synchronize a datastream sent from a central facility to a terminal in an interactive television system so that many users can initiate and interact with programs and services at different times (col. 2, lines 21-32).

As to claim 19, the method of claim 18, wherein the method further comprises: controlling the client by means of the local computer. However, Mustafa discloses the set top box (unit 33) is in communication with a local computer and associated storage and the client retrieves information from one or more of the local computer (see Fig. 1, col. 3, lines 12-20, col. 4, lines 3-

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20, and col. 6, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 18, wherein the method further comprises controlling the client by means of the local computer as taught by Mustafa within Florin and Schlafly in order to synchronize a datastream sent from a central facility to a terminal in an interactive television system so that many users can initiate and interact with programs and services at different times (col. 2, lines 21-32).

As to claim 20, Florin does not explicitly disclose the method of claim 18, wherein the local computer is part of a local area network. However, Mustafa discloses the method of claim 18, wherein the local computer is part of a local area network (see Fig. 1, col. 3, lines 12-20, col. 4, lines 3-20, and col. 6, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 18, wherein the local computer is part of a local area network as taught by Mustafa within Florin and Schlafly in order to synchronize a datastream sent from a central facility to a terminal in an interactive television system so that many users can initiate and interact with programs and services at different times (col. 2, lines 21-32).

As to claims 46-48, the claims are similar in scope to claims 18-20 and are rejected on the same basis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
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